

REMARKS

The Office Action mailed October 20, 2005 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 8-20 are now pending in this application. Claims 8, 11-16, and 18-20 stand rejected. Claims 1-7 have been canceled.

The rejection of Claims 8, 11-14, 16, 18, and 19 under 35 U.S.C. § 102(b) as being anticipated by Joecks (U.S. Pat. No. 5,319,179) is respectfully traversed.

Joecks describes a container (1) for use in welding a workpiece (7) with an arc welding process. The container (1) includes a pair of pipe ducts (14 and 15) which supply and remove, respectively, a protective gas from within the container (1). The container (1) includes a perforated base plate (4) which divides the container (1) into a working area (28) and a separate chamber at the base of the container (1) that is filled with a network of conduits that are surrounded by steel wool (3). The workpiece (7) is coupled to a rotary lifting duct means (2) within the working area (28) of the container (1). Notably, the workpiece (7) is not secured within the enclosure defined by the base plate (4), but rather is secured within the working chamber (28).

Claim 8 recites a liner assembly for a SWET box, wherein the liner assembly comprises "an enclosure configured to be received in a heating chamber of the SWET box, said enclosure comprising a rear wall, a front wall opposite said rear wall, a pair of opposed end walls, and a dividing wall defining a welding chamber therein, said welding chamber sized to receive a component being welded therein"

Joecks does not describe nor suggest a liner assembly for a SWET box as is recited in Claim 8. Specifically, Joecks does not describe nor suggest a liner assembly including an enclosure configured to be received in a heating chamber of the SWET box wherein a dividing wall defines a welding chamber therein that is sized to receive a component being welded therein. Rather, Joecks describes a container including a heat chamber that includes an enclosure defined therein that is not sized to receive a component being welded therein.

Accordingly, for at least the reasons set forth above, Claim 8 is submitted to be patentable over Joecks.

Claims 11-14 depend, directly or indirectly, from independent Claim 8. When the recitations of Claims 11-14 are considered in combination with the recitations of Claim 8, Applicant submits that dependent Claims 11-14 likewise are patentable over Joecks.

Claim 16 recites a SWET box comprising “a heating chamber . . . an enclosure configured to be received in said heating chamber, said enclosure comprising a rear wall, a front wall opposite said rear wall, a pair of opposed end walls, and a dividing wall defining a welding chamber therein, said welding chamber sized to receive a component being welded therein”

Joecks does not describe nor suggest a SWET box as is recited in Claim 16. Specifically, Joecks does not describe nor suggest a SWET box including a heating chamber and an enclosure configured to be received in a heating chamber of the SWET box wherein a dividing wall defines a welding chamber therein that is sized to receive a component being welded therein. Rather, Joecks describes a container including a heat chamber that includes an enclosure defined therein that is not sized to receive a component being welded therein. Accordingly, for at least the reasons set forth above, Claim 16 is submitted to be patentable over Joecks.

Claims 18 and 19 depend, directly or indirectly, from independent Claim 16. When the recitations of Claims 18 and 19 are considered in combination with the recitations of Claim 16, Applicant submits that dependent Claims 18 and 19 likewise are patentable over Joecks.

For at least the reasons set forth above, Applicant respectfully requests that the Section 102 rejection of Claims 8, 11-14, 16, 18, and 19 be withdrawn.

The rejection of Claims 15 and 20 under 35 U.S.C. § 103(b) as being anticipated by Joecks (U.S. Pat. No. 5,319,179) in view of Offer (U.S. Pat. No. 5,981,897) is respectfully traversed.

Joecks is described above. Offer describes a gas distribution apparatus that can be used as part of a gas tungsten arc welding system. The apparatus emits a laminar flow of inert gas at a location inside a weld groove (2). The portion of the apparatus, i.e., an electrode (8), extending into the groove (2) has a thickness that is less than the width of the groove such that during operation, the inert gas discharged from the apparatus facilitates displacing the ambient atmosphere adjacent a bottom of the groove (2). Notably, Offer does not describe nor suggest the use of a SWET box.

Applicant respectfully submits that the Section 103 rejection of presently pending claims is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been an obvious to one of ordinary skill in the art to combine Offer with Joecks. More specifically, it is respectfully submitted that a prima facie case of obviousness has not been established. As explained by the Federal Circuit, “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant.” In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). MPEP 2143.01.

Moreover, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[I]t is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Further, under Section 103, “it is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicant’s disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant’s

disclosure. In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown.

Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicant requests that the Section 103 rejection of Claims 15 and 20 be withdrawn.

Moreover, if art “teaches away” from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Applicant respectfully submit that Joecks teaches away from the present invention, and as such, thus supports the nonobviousness of the present invention. More specifically, Joecks clearly describes a container wherein the componet being welded is secured in position within a heating chamber, rather than the enclosure defined within the heating chamber. As such, the presently pending claims are patentably distinguishable from the cited combination.

In addition, no combination of Joecks and Offer describes or suggests the claimed invention. Specifically, Claim 8 recites a liner assembly for a SWET box, wherein the liner assembly comprises “an enclosure configured to be received in a heating chamber of the SWET box, said enclosure comprising a rear wall, a front wall opposite said rear wall, a pair of opposed end walls, and a dividing wall defining a welding chamber therein, said welding chamber sized to receive a component being welded therein”

No combination of Joecks and Offer describes or suggests a liner assembly for a SWET box as is recited in Claim 8. Specifically, no combination of Joecks and Offer describes or suggests a liner assembly including an enclosure configured to be received in a heating chamber of the SWET box wherein a dividing wall defines a welding chamber therein that is sized to receive a component being welding therein. Rather, Joecks describes a container including a heat chamber that includes an enclosure defined therein that is not

sized to receive a component being welded therein, and Offer does not describe nor suggest the use of a SWET box. Accordingly, for at least the reasons set forth above, Claim 8 is submitted to be patentable over Joecks in view of Offer.

Claim 15 depends from independent Claim 8. When the recitations of Claim 15 are considered in combination with the recitations of Claim 8, Applicant submits that dependent Claim 15 likewise is patentable over Joecks in view of Offer.

Claim 16 recites a SWET box comprising “a heating chamber . . . an enclosure configured to be received in said heating chamber, said enclosure comprising a rear wall, a front wall opposite said rear wall, a pair of opposed end walls, and a dividing wall defining a welding chamber therein, said welding chamber sized to receive a component being welded therein”

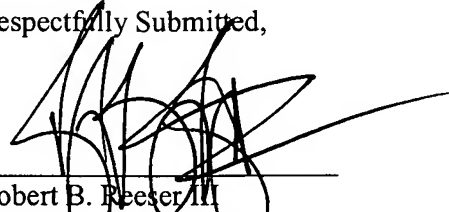
No combination of Joecks and Offer describes or suggests a SWET box as is recited in Claim 16. Specifically, no combination of Joecks and Offer describes or suggests a SWET box including a heating chamber and an enclosure configured to be received in a heating chamber of the SWET box wherein a dividing wall defines a welding chamber therein that is sized to receive a component being welded therein. Rather, Joecks describes a container including a heat chamber that includes an enclosure defined therein that is not sized to receive a component being welded therein, and Offer does not describe nor suggest the use of a SWET box. Accordingly, for at least the reasons set forth above, Claim 16 is submitted to be patentable over Joecks in view of Offer.

Claim 20 depends from independent Claim 16. When the recitations of Claim 20 are considered in combination with the recitations of Claim 16, Applicant submits that dependent Claim 20 likewise is patentable over Joecks in view of Offer.

For at least the reasons set forth above, Applicant respectfully requests that the Section 103 rejection of Claims 15 and 20 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Robert B. Reeser III', is written over a horizontal line.

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